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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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| Appl. No. | : | 09/470,874 | Confirmation No. 6721 |
| Applicant | : | Marc M. Jalisi et al. | |
| Filed | : | December 22, 1999 | |
| Title | : | COMPOSITE GUIDEWIRE WITH DRAWN AND FILLED TUBE CONSTRUCTION | |
| Art Unit | : | 3763 | |
| Examiner | : | Elizabeth MacNeill | |
| Docket No.: | : | ACSG-58267 (G1513USP1) | |
| Customer No. | : | 24201 | April 7, 2008 |

REPLY BRIEF

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated February 6, 2008. In the event that fees are required, authorization is hereby provided to charge to our Deposit Account No. 06-2425 any fees due in connection with this paper.

INTRODUCTION

I. STATUS OF CLAIMS

The status of the claims in this application are:

A. Total Number of Claims in the Application

The claims in the application are: Claims 1-15, 17, 19-27 and 29.

B. Status of All of the Claims

Each of pending claims 1-15, 17, 19-27 and 29 stand as finally rejected under 35 U.S.C.

§ 103(a) as obvious over Thome et al. (5,776,080) in view of Fagan et al. (WO 96/25969).

C. Claims on Appeals

The claims on appeal are each of pending claims 1-15, 17, 19-27 and 29.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-15, 17, 19-27 and 29 were improperly rejected under 35 U.S.C. § 103(a) as being obvious over the Thome patent in view of the Fagan reference.

III. ARGUMENT

In response to Appellant's previously submitted arguments, the Examiner states that the phrase "**concentrically arranged about**" as used in claim 1 does not have to mean outside or exterior to the superelastic layer, so the layer of resin 176 disclosed in the Thome patent meets this limitation since it is concentric to the superelastic layer 178 and abuts this layer as well. Appellant strongly disagrees with the Examiner's interpretation of the term "**concentrically arranged about**" since the resin 176 is not concentrically arranged about or around the superelastic layer 178 in any fashion. In utilizing this term, Appellant has made it explicitly clear on the record that the term denotes a structure in which the second layer covers or surrounds the outside or exterior of the layer of superelastic material. Appellant notes that one skilled in the art would recognize that the layer of resin 176 of the Thome device would be considered to be "concentrically arranged about" the inner core 154, as is shown in Figure 25 of the Thome patent. However, due to the placement of the layer of resin 176 **within**, not **about**, the layer of superelastic material 178, one skilled in the art would not consider this layer of resin 176 to be "concentrically arranged about" the superelastic layer 178. Accordingly since the layer 178 in the Thome device forms the **outermost surface** of the Thome device, the Thome patent does not disclose or even contemplate a second layer **concentrically arranged about** this layer 178. Therefore, this layer of resin 176 does not meet the claim language of being **concentrically arranged about** the superelastic layer 178. The Fagan reference, as well, fails to disclose this claimed structure. Accordingly, it is respectfully submitted that independent claim 1 and its dependent claims are not obvious in view of the cited art for at this reason alone.

With respect to independent claim 8, the Examiner takes the position that the proximal section and distal section refer only to the structure of the inner core. However, a proper reading of claim 8 shows the recitation of a composite elongate core including an inner core formed of a

precipitation hardened material concentrically surrounded by a first layer formed of a superelastic material. This composite elongate core, in turn, includes both a proximal section and a distal section. Claim 8 further recites that a flexible body, distinct from the first layer, at least partially overlays this distal section of the composite elongate core.

Appellant's reading of claim 8 is correct as the phase "proximal section and distal section" is utilized to describe the elongate core member and is in accordance with the disclosure of the presently claimed invention. The Examiner's interpretation that the phase "proximal section and distal section" should refer only to the inner core is not a reasonable reading of claim 8 and is not in accordance with the disclosed invention. One particular embodiment of Appellant's presently claimed invention is shown in Figure 1 of the specification which clearly depicts the composite elongate core, made from both the inner core and layer of superelastic material, extending to a distal section. A flexible body (in the form of a helical coil) partially covers the distal section of this composite elongate core.

The Examiner takes the position that the layer of resin 176 in the Thome device corresponds to the flexible body recited in claim 8. The Examiner has not demonstrated, however, that the layer of resin 176 at least partially **overlays** the elongate core member made up of both the inner core and layer of a superelastic material, as recited in claim 8 and its dependent claims. Rather, the Examiner's position is only supported when claim 8 is read incorrectly as the Examiner has done. However, when claim 8 is properly read, it is apparent that the layer of resin 176 in the Thome device only overlays the inner core 154 and not the distal section of the composite elongate core member (i.e., the inner core 154 and layer of superelastic material 178). Accordingly, it is respectfully submitted that claim 8 and its dependent claims recite subject matter which is patentable over the cited art.

As to independent claims 26 and 27, the Examiner merely states that the interpretation relating to claim 8 applies equally to claims 26 and 27. It is again respectfully submitted that the Examiner's asserted definition of "distal end" is misplaced and contrary to the correct reading of the phrase "proximal section and distal section" as addressed above with regard to claim 8. Therefore, it is respectfully submitted that claims 26 and 27 also define subject matter which is allowable over the cited art.

It is further respectfully submitted that the combined teachings of the Thome patent and the Fagan reference do not render obvious the subject matter recited in independent claims 26 and 27. Significantly, claim 26 recites a guide wire including a flexible coil disposed at a distal end of a distal section of a composite elongate core and independent claim 27 recites a heat-treated elongate member including a flexible body disclosed at a distal end of a distal section of a composite elongate core, and both claims 26 and 27 recite a composite elongate core including an elongate core formed of a precipitation hardenable material concentrically surrounded by a layer formed of a superelastic material, wherein the precipitation hardened material and superelastic material extend through at least the part of a length of the flexible body. It is to be noted that the multi-layered strands 182 of Thome device, upon which the Examiner relies as defining a flexible coil, are shown in the drawings as terminating **proximal** of the distal end of the device (See Figures 26 and 27). Furthermore, the multi-layered strands 182 are described in the Thome patent as providing the operative segment 150 (defined in the Thome patent as similar to operative segment 52, which is shown and described as the **proximal most portion** of guide wire 36) with increased pushability and torqueability performance. Increased pushability and torqueability are usually associated with components located at the proximal, not the distal portion of a guide wire. Accordingly, it is submitted that the Thome patent clearly does not teach a guide wire having a flexible coil disposed at a distal end of a distal section as is recited in

independent claim 26 or for that matter, a heat-treated elongate member including a flexible body disposed at a distal end of the distal section as recited in independent claim 27.

Independent claims 1, 8, 26 and 27 as well as their respective dependent claims recite subject matter which is patentable over the cited art. Again, it is respectfully submitted that improper hindsight in conflict with the guidance provided by MPEP 2143 may have been employed to modify the teachings of the Thome patent in view of the Fagan reference. In fact, the Examiner has only provided a reason for combining the teachings of the Thome patent and the Fagan reference when discussing independent claim 1 and in that regard, the Examiner has merely stated that modifying the Thome patent in view of the Fagan reference would have been obvious to one of ordinary skill in the art because the two materials are equivalents and are readily interchangeable. Appellant disagrees that these two materials are equivalents since these materials convey different physical properties, especially when combined with other different layers of materials as recited in the claims. It is respectfully submitted that the Examiner's reasoning falls short of what is necessary to establish a *prima facia* case of obviousness and the combination suggested by the Examiner is merely the result of using hindsight reconstruction in attempting to recreate Appellant's presently claimed invention. Moreover, there is much more structural features to the claims that have to be considered, not just mere interchanging of materials. Appellant submits that the Examiner has thus failed to establish a *prima facia* case of obviousness.

Accordingly, it is respectfully submitted that the Thome patent and the Fagan reference do not render obvious the subject matter recited in claims 1-15, 17, 19-27 and 29. As such, it is respectfully submitted that each of claims 1-15, 17, 19-27 and 29 were rejected in error. It is

respectfully requested that the Board reverse the rejection of the claims and allow the claims 1-15, 17, 19-27 and 29 to pass to issue.

Respectfully submitted,
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